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HP Docket No. 200208780-1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl. No.	:10/827,163	)
Conf. No.	:2669	)
Applicant	:Benjamin et al.	)
Filed	:04/19/2004	)
Title	:Fluid Ejection Device	)
		)
TC / Art Unit	:2853	)
Examiner	:Martin, Laura E.	)
		)
Docket No.	:200208780-1	)
Customer No.	:022879	)

Commissioner for Patents

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Alexandria, VA 22313-1450

**RESPONSE TO ELECTION OF SPECIES REQUIREMENT**

Sir:

The Office Action dated 12/28/2006 has been carefully considered. In response thereto, please enter the following election and consider the following remarks.

**ELECTION**

The Office states that Species III (claims 23-45), which was elected for prosecution in response to the previous restriction requirement, contains sub-species therein. The Office states that the claims of elected Species III contains claims directed to eight (8) patentably distinct sub-species, and requires election for prosecution of one of Sub-species 1a, 1b, 1c, 1d, 2a, 2b, 3a, or

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3b.

In response to the restriction requirement, Applicants elect Sub-species 1a. Claims 23-29, 33-34, 37, and 40-45 are readable on elected Species I. It is requested that claim 23 be designated as generic.

This election is made *with traverse*.

First, in the interests of *equity and fairness*, Applicants should be entitled to pursue different alleged sub-species of claims in the present application, so as to fully protect the disclosed invention. Applicants have already borne the cost of responding to a second restriction requirement immediately after the first. If the restriction is maintained, Applicant may need to bear the costs associated with pursuing as many as eight (8) different patent applications to protect each sub-species of claim, and conceivably pay as many as eight different maintenance fees if patents are granted. This would be in addition to bearing the costs associated with pursuing as many as four (4) additional patent applications, and paying as many as four (4) different maintenance fees, to protect each species of claim not elected in response to the previous restriction requirement. In addition, if the Office pursues a similar tactic in identifying and requiring election of Sub-species in the four non-elected Species, the number of additional patent applications for this invention could multiply geometrically. Such an outcome would not be fair and equitable to Applicants, who have already paid for examination of each of the claims through additional filing fees for the present application.

Second, MPEP §803 states that "a second [restriction] requirement may be made *when it becomes proper*, even though there was a prior requirement with which applicant complied" (emphasis added). Here, a first restriction requirement was issued in the previous office action, in response to which Applicants elected Species III. It is particularly noted that none of the claims of the present application were amended by Applicants in that response. Accordingly, there is no reason why the Office could not, at the time of the *first* restriction requirement office action, have

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identified the Sub-species now associated with Species III. Therefore, if a restriction requirement for sub-species is proper at all (see point three, below), it would have become proper at the same time that the *first* restriction requirement was issued. No event has occurred since the time of the first restriction requirement to make the present restriction requirement become proper. If the Office maintains that such an event did occur, it is respectfully requested that such event be clearly identified to Applicants in the next Office Action.

Third, the *authority* for the Office's issuance of a restriction requirement to a Sub-species of an elected Species is unknown. The MPEP does not, to the knowledge of Applicants' attorney, define Sub-species, nor provide any authority for restricting examination based on Sub-species of an elected Species. If such definition and authority exist and have been overlooked by Applicants' attorney, it is respectfully requested that the Office clearly identify the definition and authority with specificity in the next Office Action. Otherwise, it is respectfully believed that the issuance of the present restriction requirement to sub-species is improper.

Fourth, MPEP §806.04(f) states that "a requirement for restriction to a single species may be proper if the species are *mutually exclusive*". Here, the identified species are not mutually exclusive. With regard to elected Sub-species 1a, Sub-species 1b is not mutually exclusive with Sub-species 1a in that the set of seven address signals in an address timeslot can include two active address signals. Sub-species 1c is not mutually exclusive with Sub-species 1a in that the set of seven address signals can be provided in the thirteen address timeslots. Sub-species 1d is not mutually exclusive with Sub-species 1a in that the set of seven address signals can be provided in the fourteen address timeslots. Sub-species 2a is not mutually exclusive with Sub-species 1a in that the seven address signals of a set can include different active address signals during each of the thirteen address timeslots. Sub-species 2b is not mutually exclusive with Sub-species 1a in that the seven address signals of a set can include different active address signals during each of the fourteen address timeslots. Sub-species 3a and 3b are not mutually exclusive with Sub-species 1a in that the set of seven address signals provided during each of the address timeslots is a different element from the series of energy pulses.